

REMARKS

Claims 1-17 are pending in this Application. In the Office Action mailed March 22, 2006, the Examiner:

1. Objected to Claims 3, 7 and 10 due to minor informalities;
2. Rejected Claims 1-14 under 35 U.S.C. § 112, second paragraph for being indefinite;
3. Rejected Claim 1 under 35 U.S.C. § 102(b) as being anticipated by Ettore et al. (U.S. Patent No. 3,475,261); and
4. Rejected Claims 1, 4, 5 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Simms (U.S. Patent No. 3,133,854) in view of Ettore et al. and Petropoulos et al. (U.S. Patent No. 3,313,675; herein "Petropoulos").
5. Rejected Claims 2, 3 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Simms, Ettore et al. and Petropoulos as applied to Claim 1 and 5 and further in view of Ewaschuk (U.S. Patent No. 5,728,246);
6. Rejected Claims 4-6, 8 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Simms, Ettore et al. and Petropoulos as applied to Claim 1 and 5 and further in view of admitted prior art;
7. Rejected Claims 1 and 12-14 under 35 U.S.C. § 103(a) as being unpatentable over Petropoulos, Ettore et al. and Yang (U.S. Patent No. 6,020,429).

Applicants respectfully address the Examiner's objections and rejections below.

Claims Objection

On page 2 of the Office Action, the Examiner rejected Claims 3 and 7 for grammatical reasons. Applicants respectfully submit amended Claims 3, amended as recommended by the Examiner in which the term "between about 1/16 inch to ¼ inch" is replaced with the term "between about 1/16 inch and ¼ inch." Claim 7 has been cancelled without prejudice. No new matter has been introduced with the amendment.

The Examiner also objected to Claim 10 for including a singular form of "material." Applicants thank the Examiner for pointing this out and respectfully submit amended Claim 10, amended to include a plurality of support "materials" as recommended by the Examiner. No new matter has been introduced with this amendment. Applicants respectfully request entry and allowance of amended Claims 3 and 10, believed to overcome the Examiner's objections.

Claims Rejection - 35 U.S.C. § 112, second paragraph

On page 2 of the Office Action, the Examiner rejected Claims 1-14 for being indefinite and not particularly pointing out and distinctly claiming the subject matter regarded as the invention.

For Claim 1, the Examiner states, "it is unclear what material in the claim is the fiber cement board as it is not in the body of the claim." Applicants respectfully submit amended Claim 1, amended to include "a fiber cement assembly comprising a substrate, a first layer, a second layer, and a fluorocarbon film" and that "the substrate is selected from the group consisting of a

fiber reinforced material, a metal material, a plastics material, a wood material and combinations thereof." [Emphasis shows amended text.] Support for amended Claim 1 is provided throughout the Specification, at e.g., paragraphs [0011], [0014]-[0016], [0022], and [0048]. In particular, the substrate may include a combination of materials as pointed out in the specification as *comprising* fiber reinforced material, a metal material, a plastics material, or a wood material (e.g., para. [0014]) and as further exemplified in Examples 3-7 in which an assembly includes a combination material. No new matter has been introduced with such amendments to Claim 1.

Claim 7 is said to be similar to Claim 3. Applicants cancel Claim 7 without prejudice.

Claim 9 is said to be unclear with regards to the rubber thickness. Applicants submit amended Claim 9, amended to include "wherein the vertical members have a thickness greater than the thickness of the substrate plus the second layer of adhesive and the film." No new matter has been introduced with this amendment.

Claim 10 is said to be unclear as to "whether each of the support materials has a width smaller than that of the substrate or whether all of them taken together do." Applicants respectfully submit amended Claim 10, amended to include "each support material having a width smaller than the width of the substrate." [Emphasis shows amended text.] Support for amended Claim 10 may be found throughout the Specification, at e.g., para. [0062]. Applicants respectfully request entry and allowance of amended Claims 1, 9 and 10, believed to overcome the Examiner's

rejections and to particularly point out and distinctly claim the subject matter that Applicants regard as their invention.

Claim Rejection - 35 U.S.C. § 102(b)

On page 3 of the Office Action, the Examiner rejected Claim 1 as being anticipated by Ettore et al. (herein "Ettore"). The Examiner states:

"Ettore et al. discloses a method of applying a polyvinyl fluoride film to a substrate by applying adhesive to the front, back, and sides of the substrate, placing the polyvinyl fluoride film on the substrate, wrapping the film around the substrate to contact the back and sides (34; Figure 4), and applying heat and pressure so the film is bonded to the back and sides of the substrate. (Col. 1, ll. 55-66; Col. 5, ll. 35-38, 59-61; Col. 6, ll. 33-35). . . It is noted that all materials have a texture of some sort, be it smooth or rough."

Applicants respectfully disagree with the Examiner's statement and specifically point out that Ettore does not teach expressly or inherently each and every element of Applicants' claimed invention. For example, as stated by the Examiner, Ettore teaches "applying adhesive to the front, back, and sides of the substrate" and "wrapping the film around the substrate to contact the back and sides." This is unlike Applicants' claimed invention in which it is claimed that a first surface and second surface of the substrate include an adhesive mixture. And, unlike Applicants' claimed invention, Ettore specifically teaches an "encapsulation" of its panel so that the front, sides and back of the panel are laminated with a film (Col. 2, ll. 41-48; Col. 5, ll. 66-68; FIGURES 4 and 4A; Col. 7, ll. 50-52). As such, Ettore specifically requires encapsulating a panel with a film which

requires all sides of the panel to be coated with adhesive and with a film. Furthermore, Applicants point out that unlike Applicants' claimed invention, Ettore specifically teaches a series of steps none of which are performed at the same time, in which the method first requires applying adhesive to the panel then requires applying heat to the panel to "dry and heat the adhesive" (see, zones 28, FIGURE 1, Col. 4, ll. 55-58), then requires air-drying or applying additional heat to the adhesive-coated panel to remove solvent (see zone 33, FIGURE 1; Col. 5, ll. 52-61) which is then followed by wrapping a film around the panel in the absence of heat (see zone 34, FIGURE 1; Col. 5, ll. 66-75). In addition, Ettore teaches that encapsulation of its panel specifically requires a complicated conveyor system as shown in FIGURE 1 with "rolls used in series" to sequentially wrap a film on each surface of the panel (Col. 7, ll. 9-12). Accordingly the above teachings show that Ettore does not teach or suggest the claimed method of amended Claim 1. In addition, Applicants point out that as disclosed above, Ettore does not teach or suggest "applying heat and pressure to the film in a manner such that the film is bonded to the first surface and second surface of the substrate at the same time" as claimed in amended Claim 1. Furthermore, Applicants point out that Ettore does not teach or suggest "the texture of the first surface is transferred through the film" as claimed by amended Claim 1. Instead, Ettore specifically teaches that "to produce beauty and a textured surface" requires rollers 82 that have "a series of preferably circumferential grooves" which are used to produce a required textured surface on the film (Col. 6, ll. 2-23). As such, Applicants submit that Ettore does not anticipate amended Claim 1

because, for the reasons set forth above, each and every element of amended claim is not found, either expressly or inherently, in Ettore. Applicants respectfully request removal of the rejection and entry and allowance of amended Claim 1 as provided in the Amendments to the Claims beginning on page 5 of this paper.

Claims Rejection - 35 U.S.C. § 103(a)

On page 4 of the Office Action, the Examiner rejected Claims 1, 4, 5, and 11 for being unpatentable over Simms in view of Ettore and Petropoulos and rejected Claims 1 and 12-14 under as being unpatentable over Petropoulos, Ettore and Yang. Applicants respectfully disagree and firstly point out that neither Simms, Petropoulos, Ettore or Yang teach or suggest Applicants' claimed invention as a whole. For example, unlike Applicants' claimed invention, Simms specifically teaches polyvinyl fluoride does not typically "adhere to other materials" (Col. 1, ll. 19-20). As such, Simms specifically teaches and requires a complicated method to provide an activated layer so that at least one surface of polyvinyl fluoride film is "chemically activated" by an acid, an open flame and "subjecting the film to high-frequency, spark discharge" (Col. 2, ll. 38-48). Accordingly, Simms teaches away from Applicants' claimed invention by teaching that a polyvinyl fluoride film is not a suitable film unless first chemically activated. Furthermore, Simms teaches an entirely different method in which an adhesive is first coated on a substrate, followed by heating the adhesive which is then followed by applying the polyvinyl fluoride film to the adhesive (Col. 6, ll. 2-10). Once the film is adhered to the substrate, the

resulting product is then nip rolled or pressed. Accordingly, Simms does not teach or suggest all the claim limitations of amended Claim 1 nor Applicants' claimed invention as a whole. Applicants further point out that there is no suggestion or motivation in Simms to teach Applicants claimed method nor would one of ordinary skill in the art arrive at Applicants' claimed invention by viewing the disclosure provided by Simms, particularly because Simms requires different elements and limitations, teaches an entirely different method and teaches away portions of from Applicants' claimed invention. Contrary to the Examiner's suggestions, Ettore does not provide any suitable teachings of the method as disclosed by Applicants claimed invention for the reasons set forth above. For example, as previously pointed out by Applicants, Ettore teaches an entirely different method, such as an inability to teach "applying heat and pressure to the film in a manner such that the film is bonded to the first surface and second surface the substrate at the same time." and, thus, teaches away from Applicants' claimed invention. As such, and contrary to the Examiner's statement that "it would have been obvious to one of ordinary skill in the art. . . to bond the polyvinyl fluoride to the substrate in Simms using the process of Ettore," Applicants submit that Simms cannot be modified to include any method, particularly one disclosed by Ettore in order to teach Applicants' claimed invention. This is because both Simms and Ettore are unpredictable with respect to Applicants' claimed invention and at least some predictability is required for a showing of obviousness. For this reason, Applicants point out that should Simms be modified to include a method of Ettore,

Petropoulos, Yang, and/or Ewaschuk, such a combination would not teach or suggest teach or suggest all the claim limitations of amended Claim 1 nor Applicants' claimed invention as a whole. The deficiencies in Simms are not overcome by any other reference teachings, such as Ettore, Petropoulos, Yang, Ewaschuk or any combination thereof and such combinations will not make obvious Applicants' claimed invention. Moreover, because both Simms and Ettore teach away from Applicants' invention as a whole, both Simms and Ettore are each unpredictable with respect to Applicants' claimed invention so that there is no reasonable expectation of success to modify Simms or Ettore with any other reference as suggested by the Examiner, including, Petropoulos, Ewaschuk or Yang. The preponderance of evidence showing that there is no reasonable expectation of success to modify Simms or Ettore and that both Simms and Ettore are, themselves, unpredictable with regards to amended Claim 1 supports a conclusion of nonobviousness. Combining Ettore with Petropoulos, Yang, Ewaschuk and/or admitted prior art do not overcome the deficiencies in Ettore as previously pointed out by Applicants, in which it was shown that Ettore teaches away from Applicants' claimed invention and does not teach all the claim limitations of amended Claim 1 nor Applicants' claimed invention as a whole. As such, it is reiterated that Ettore is unpredictable with regards to amended Claim 1 and some predictability is required for a showing of obviousness. Accordingly, Applicants respectfully submit that amended Claim 1 is not obvious over Simms in view of Ettore and Petropoulos nor is this claim obvious over Petropoulos, Ettore and Yang. As such, Applicants respectfully request entry and allowance of

amended Claim 1 and all claims depending therefrom as provided in the Amendments to the Claims beginning on page 5 of this paper.

Applicants respectfully submit new Claims 15-21, Claims believed to be patentably distinct from the cited references and to be necessary to protect Applicants' invention. No new matter has been introduced with amended Claims 15-21. Support for these new claims may be found throughout the Specification, see e.g., para. [0012], [0020], and [0022]. Applicants respectfully request entry and allowance of new Claims 15-21.

Paragraphs [0014] and [0022] have also been amended with this paper to more clearly describe the claimed invention and to correct typographical errors. No new matter has been introduced with these amendments and Applicants respectfully request entry and acceptance of amended paragraphs [0014] and [0022].

CONCLUSION

Applicants respectfully submit that the Application is in condition for allowance, and pursuant to the filing of this Amendment and a Request for Continued Examination Applicants earnestly seek such allowance of Claims 1-14 as well as new Claims 15-21. Should the Examiner have questions, comments, or suggestions in furtherance of the prosecution of this Application, please contact Applicants' representative at 214.999.4330. Applicants, through their representative, stand ready to conduct a telephone interview with the Examiner to review this Application if the Examiner believes that such an interview would assist in the advancement of this Application.

To the extent that any further fees are required during the pendency of this Application, including petition fees, the Commissioner is hereby authorized to charge payment of any additional fees, including, without limitation, any fees under 37 C.F.R. § 1.16 or 37 C.F.R. § 1.17, to Deposit Account No. 07-0153 of Gardere Wynne Sewell LLP and reference Attorney Docket No. 129843.1037. In the event that any additional time is needed for this filing, or any additional time in excess of that requested in a petition for an extension of time, please consider this a petition for an extension of time for any needed extension of time pursuant to 37 C.F.R. § 1.136 or any other section or provision of Title 37. Applicants respectfully request that the Commissioner grant any such petition and authorize the Commissioner to charge the Deposit Account referenced above. Please credit any overpayments to this same Deposit Account.

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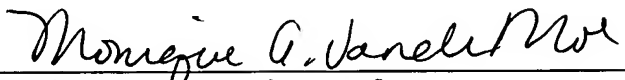
AMENDMENT AND RESPONSE
APPLICATION NO. 10/791,970

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This is intended to be a complete response to the Office
Action mailed March 22, 2006.

**Please direct all correspondence to the practitioner listed
below at Customer No. 60148.**

Respectfully submitted,



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